

REMARKS

The Official Action of October 11, 2007, has been carefully reviewed. The claims in the application are now claims 1-9 and 20-30, and these claims define patentable subject matter warranting their allowance. Applicant again requests favorable reconsideration and allowance.

Claims 1 and 20 have been amended to include a part, respectively, from claims 5 and 23. New dependent claims 27-30 have been added, these finding support for example in the figures, e.g. Fig. 4 for claims 29 and 30. The newly added dependent claims are patentable **at least** because they depend from and incorporate the subject matter of independent claim 1 or 20.

Claims 20-26 have been rejected as anticipated by Gu. The rejection is respectfully traversed.

Claim 20 is independent and claims 21-26 depend directly or ultimate from claim 20 and incorporate the subject matter of claim 20. Thus, if claim 20 defines novel subject matter over Gu, as it does as pointed out below and previously, then it follows that all of claims 20-26 define novel subject matter of Gu and thus are not anticipated by Gu.

Claim 20 includes the following recitation: "a blocking member (12) disposed within the inner chamber (5) adjacent to the inlet opening (18) in the capsule wall (3),...". As pointed out previously, there is no way that Gu discloses such a blocking member, because in Gu the edges of the body 10 which define the inlet opening 20 also serve as a blocking member, and there is **no** "blocking member disposed within the inner chamber [interior 40] adjacent to the inlet opening 20 in the capsule wall [body 10]".

The same element, i.e. the inlet opening 20 formed by the edges of the body 10, cannot be validly read on two different aspects of applicant's invention. Applicant respectfully repeats by reference the arguments previously made on this point.

To bring out this feature even more clearly, a part of claim 23 has now been inserted into claim 20. It should be clear that Gu does not show both an inlet opening 20 in the wall of the hollow body 10, and **also** a laterally located aperture in any blocking membrane.

In paragraph 27 (page 9) of the Office Action, it is stated that claim 20 does not positively recite the language of amended claim 1. However, it does call for, contrary to the implication of paragraph 27, a blocking membrane disposed within the inner chamber adjacent to the inlet opening in the capsule wall, and this is structure which is clearly not possessed by Gu.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-3 and 7 have been rejected as obvious from Gu in view of newly cited Bucalo USP 4,257,427 (Bucalo). This rejection is respectfully traversed.

Gu has been discussed previously and above, and applicant's remarks are respectfully repeated by reference.

Bucalo relates to a method for collecting body fluids, and its disclosure at column 7, line 43 through column 9, line 23, and in Fig. 5, is particularly referred to in the Office Action. Applicant agrees that the structure and function of Bucalo is clearly described in the portion thereof referred to in the rejection. However, the function is rather complicated and indeed is unreliable. For example, when under-pressure is achieved, the flap valve 70 is maintained in

closed position by a magnetic ball 74, and released when the valve should be opened.

A first question is why a person of ordinary skill in the art would even want to begin to modify Gu by anything disclosed in Bucalo. A reading of Gu would suggest that there is no need for any separate blocking member, e.g. the blocking member (70) of Fig. 5 of Bucalo. Adopting such an additional feature in Gu would be a complicating factor, making the Gu device more complex and more expensive, and seemingly without any reason to do so. Therefore, the proposed combination would not have been obvious to the person of ordinary skill in the art at the time the present invention was made.

Moreover, even if the proposed combination were obvious (strongly traversed by applicant), the claimed subject matter would still not be achieved because the flap valve 70 of Bucalo is not spaced from the inlet opening, but is and must be maintained flush against the inlet opening. When the magnetic attracting force keeping the flap valve 70 tightly against the inlet opening is released, the flap valve 70 merely falls away and is never "adjacent to and spaced from the inlet opening" as claimed.

Moreover, claim 5 was not subject to the rejection based on Gu in view of Bucalo. A feature from claim 5, as noted above, has now been incorporated into claim 1, and it is clear that no combination of Gu in view of Bucalo (even if obvious, respectfully denied) could reach the feature added from claim 5 to claim 1.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 4-6, 8 and 9 have been rejected as obvious under Section 103 from Gu in view of Bucalo and further in view of Pawelec. This rejection is respectfully traversed.

Gu and Bucalo, and their proposed combination, have been discussed above, and such comments are respectfully repeated by reference. The combination of Gu and Bucalo would not have been obvious, and in any event would not reach the features of even claim 1, let alone that of dependent claims 4-6, 8 and 9, which depend from and incorporate the features of claim 1.

Pawelec has been previously applied, and applicant respectfully repeats by reference the remarks concerning any combination of Gu in view of Pawelec, such as those set forth beginning on page 10 of the Reply filed July 12, 2007. Briefly, there is no reason apparent in the prior art for any such combination, Gu and Pawelec are antithetical to one another making their combination clearly non-obvious, and the combination in any event would not reach the subject matter of claim 1, let alone the claims which depend therefrom.

In paragraphs 16 and 20, the Office Action states that all the claimed elements were known in the prior art, the implication being that simply because all parts were known in the prior art, it would have been obvious to put them together to achieve applicant's device. First, however, all the parts were **not** in the prior art, as pointed out above and previously.

But second, even if the parts were all separately known in the prior art, respectfully denied, that does not automatically lead to a conclusion of obviousness. One issue under Section 103 is what do the references fairly teach or suggest to the person of ordinary skill in the art. Stated another way, where do the references lead the person of ordinary skill in the art (*Ex parte Levengood*, 28 USPQ2d 1300; *In re Zurko*, 42 USPQ2d 1476). The various options of Bucalo and Pawelec do indeed provide concrete teachings or "leadings", but not toward applicant's invention. The various

options of Bucalo and Pawelec are so immense that they led the person of ordinary skill in the art in no particular direction, but at best in many possible directions. In this regard, attention is invited to *Ex parte Garvey*, 41 USPQ 583 (1939) in which the Board stated:

The likelihood of producing a composition such as here claimed from a disclosure such as shown by the Dykstra patent would be about the same as the likelihood of discovering the combination of a safe from a mere inspection of the dials thereof.

* * *

..., as in the Dykstra et al disclosure, the proper one of large number of possible permutations must be chosen to bring the disclosure within the terms of the claims on appeal. Under such circumstances, we do not feel that the patent is a fair reference.

The same idea was expressed in *Laitram Corp. v. Cambridge Wire Cloth*, 226 USPQ 289, 293 (1985) where it was stated:

To illustrate this notion, you cannot claim that the existence of a unicorn should be obvious from taking a trip to the zoo and seeing a horse and a white rhinoceros in adjacent cages. It takes a spark of inventiveness to look at a horse and then look at a white rhinoceros and then conceive the idea of a white horse with a horn.

The point applicant wishes to emphasize in this regard is that the options mentioned in Bucalo and Pawelec are so numerous as to really provide no guidance that one should follow any particular option.

The references are contradictory to one another, and there is no reasonable way that the person of ordinary skill

in the art could have put them together in such a way, at the time the present invention was made, to reach the claimed subject matter.

On this particular point, applicant relies primarily on *Ex parte Levengood*, supra, where the examiner also stated that all features were "well known in the art", and where the Board reversed the rejection.

Similar to *Levengood*, the rejections in the present case seem to be based in part on the idea that it is proper to combine diverse elements from different references merely because it is possible to do so, but that is not the correct standard.

In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present **evidence** [footnote, including cited cases, omitted], preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art **would have been led** to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. See, for example, *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

In the present case, as in *Levengood*, the prior art would not have led the person of ordinary skill in the art to applicant's invention.

In this case,...., the only suggestion for the examiner's combination of the isolated teachings of the applied references improperly stems from appellant's disclosure and not from the applied prior art. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979). At best the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant

art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. See *Orthokinetics Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. *Ex parte Gerlach*, 212 USPQ 471 (Bd. App. 1980). See also footnote 16 of *Panduit Corp. V. Dennison Mfg. Co.*, 774 F.2d 1082, 1092, 227 USPQ 337, 343 (Fed. Cir. 1985).

In other words, simply because elements may be present in different places in the prior art, and simply because workers in the field are skilled, does not mean that it would have been obvious to combine various diverse features. There must have been some reason to do so, and no such reason exists for the proposed combinations.

That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.

Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). *In re Newell*, 891 F.2d 899, 13 USPQ 2d 1248 (Fed. Cir. 1989). Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also

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providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.

There is nothing in the prior art which would have impelled one skilled in the art to do what the applicant has done.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 22-24 and 26 have been rejected as obvious under Section 103 from Gu in view of Pawelec. This rejection is respectfully traversed.

Applicant respectfully disputes much of what is stated in the rejection, and applicant further maintains that the proposed combination of Gu and Pawelec makes no sense at all. Respectfully, the rejection is based on the teachings of applicant's own specification, which of course was not available to the person of ordinary skill in the art at the time the present invention was made.

Taking claim 22 as one example, if the lips of the Gu body 10 form a blocking member as the examiner has proposed, that leaves no room or reason for a second blocking member, let alone a second blocking member retained in the capsule wall between a cap member and a body member.

As regards claim 23, applicant respectfully disputes that Gu shows any ball shaped blocking member.

As regards claim 24, again if the lips in Gu form a sealing member as the examiner has stated, then there is no room or reason for a blocking membrane clamped between a cap member and a body member.

As regards claim 26, the rejection alleges that Pawelec discloses a filter (12). Element 12 in Pawelec is a pin, noting the sentence spanning columns 5 and 6.

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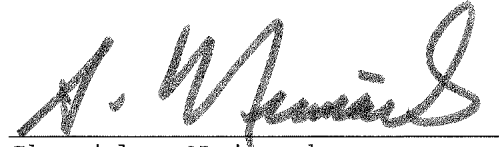
Withdrawal of the rejection is in order and is respectfully requested.

All the issues raised in the Official Action are addressed above. The rejections should be withdrawn and the claims allowed. Applicant accordingly respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

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By

A handwritten signature in dark ink, appearing to read "S. Neimark", written over a horizontal line.

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